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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/046,681	01/10/2002	Guoqing Chen	A-733A	1839
7590 11/15/2004			EXAMINER	
U.S. Patent Operations/JWB			RAYMOND, RICHARD L	
Dept. 4300, M/S AMGEN INC.	S 27-4-A		ART UNIT	PAPER NUMBER
One Amgen Center Drive			1624	
Thousand Oaks, CA 91320-1799			DATE MAILED: 11/15/2004	1

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
Office Action Symmony	10/046,681	CHEN ET AL.				
Office Action Summary	Examiner	Art Unit				
	Richard L. Raymond	1624				
The MAILING DATE of this community Period for Reply	ication appears on the cover sheet wi	th the correspondence address				
A SHORTENED STATUTORY PERIOD FOR THE MAILING DATE OF THIS COMMUNI - Extensions of time may be available under the provisions after SIX (6) MONTHS from the mailing date of this common of the period for reply specified above is less than thirty (3). If NO period for reply is specified above, the maximum states are the period for reply any reply received by the Office later than three months a earned patent term adjustment. See 37 CFR 1.704(b).	CATION. of 37 CFR 1.136(a). In no event, however, may a renunication. 0) days, a reply within the statutory minimum of thirty atutory period will apply and will expire SIX (6) MON will, by statute, cause the application to become AB.	eply be timely filed y (30) days will be considered timely. THS from the mailing date of this communication. ANDONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) file	ed on 20 September 2004.					
2a) This action is FINAL.	This action is FINAL . 2b) This action is non-final.					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4) ⊠ Claim(s) <u>1-38 and 40-69</u> is/are pend 4a) Of the above claim(s) <u>2,3,6-9,12-</u> 5) ☐ Claim(s) is/are allowed. 6) ⊠ Claim(s) <u>1,4,5,10,11,16-22,35,43-55</u> 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restrice	-15,23-34,36-38,40-42,56,57 and 64- 5 and 58-63 is/are rejected.	-69 is/are withdrawn from consideration.				
Application Papers						
9)☐ The specification is objected to by the	e Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including	the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).				
11)☐ The oath or declaration is objected to	by the Examiner. Note the attached	Office Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
2. Certified copies of the priority3. Copies of the certified copies	documents have been received. documents have been received in Aport the priority documents have been nal Bureau (PCT Rule 17.2(a)).	pplication No received in this National Stage				
Attachment(s)	•					
1) Notice of References Cited (PTO-892)		ummary (PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (P ⁻ 3) Information Disclosure Statement(s) (PTO-1449 or I Paper No(s)/Mail Date 6/14/02,10/14/02,12/ 8 0 ⁻ 3	PTO/SB/08) 5) Notice of In)/Mail Date Iformal Patent Application (PTO-152) 				

Application/Control Number: 10/046,681

Art Unit: 1624

DETAILED ACTION

Response to Restriction/Election of Species

- 1. Pursuant to the requirement for restriction, applicants have elected the invention of Group I without traverse. As noted by applicants, claims 43-45 should have been included in Group I and claim 38 in Group II. Accordingly, claims 36-38, 40-42 and 64-68, drawn to methods of use, stand withdrawn from further consideration as being to a nonelected invention.
- 2. Pursuant to the requirement for election of species, applicants have elected the compound of Example 946, a compound where the A ring is a pyridyl ring. Claims 1, 4, 5, 10, 11, 16-22, 35, 43-55 and 58-63 are readable thereon. Claims 2, 3, 6-9, 12-15, 23-34, 56 and 57 stand withdrawn as not being readable on the elected species.

Improper Markush Rejection

3. Claims 1, 4, 5, 10, 16, 21, 22, 35, 55, 58 and 60-63 are rejected as being improper Markush claims in the definition of the A ring as diverse heterocyclic rings as well as naphthyl and cycloalkenyl rings. So substituted, the resulting total compounds lack a common core and read on structurally diverse and patentably distinct compounds. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Further, an undue search burden is involved as searches in various subclasses in compound classes 540, 544, 546, 548, 549, 558,

Application/Control Number: 10/046,681

Art Unit: 1624

560, 562 and 564, the corresponding subclasses in composition class 514, and diverse structures in the literature (STN/CAS) would be required. Limitation of the claims to compounds where the A ring is a pyridyl ring, encompassing the elected species, will overcome this rejection.

Obviousness-type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, 5, 10, 11, 16-18, 35, 43-55 and 58-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the compound and composition claims of copending child Application No. 10/197,974. Although the conflicting claims are not identical, they are not patentably distinct from each other because common species are present in both sets of claims which anticipate one another. When not anticipated, the genus of one renders the claims of the other obvious. The motivation for selection comes from the common specifications.

Page 4

Application/Control Number: 10/046,681

Art Unit: 1624

6. This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 8. Claims 1, 4, 5, 10, 11, 16-18, 35, 43-55 and 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Betageri et al. See Column 47, compound 879, and the corresponding STN/CAS printout.

Claim Rejections - 35 USC § 103

- 9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Application/Control Number: 10/046,681

Art Unit: 1624

- 10. Claims 1, 4, 5, 10, 11, 16-22, 35, 43-55 and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betageri et al., above. Where not anticipated, one would be motivated to prepare the present compounds from within the genus of the reference (see formula I and the R⁴ definition as pyridyl) and/or to prepare the simple alkyl homologs, halo analogs and position isomers of the specific compounds of the reference with the reasonable expectation of obtaining additional useful anti-inflammatory agents (the use of the reference compounds). In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.
- 11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Potential Interference

12. The Manley et al. U.S Patent No. 6,624,174 and Beight et al. U.S. Patent No. 6,689,780 appear to claim subject matter within the present claims. Since the effective filing dates of the patents are subsequent to the effective filing date of the present application no prior art rejection has been made; however, since two patents cannot issue on the same invention, interference proceedings may be necessary.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (571) 272-0673. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Richard L. Ráymor Primary Examiner

Art Unit 1624

November 12, 2004